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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,515	04/07/2005	Takenobu Sunagawa	Q86666	5345
23373	7590	03/18/2008		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER BERNSHTEYN, MICHAEL	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			03/18/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/530,515

**Applicant(s)**

SUNAGAWA ET AL.

**Examiner**

MICHAEL M. BERNSTEYN

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 04/07/05, 03/07/07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action follows a response filed on December 19, 2007. Claims 1, 2, 8 and 9 have been amended; claim 7 has been cancelled; no claims have been added.
2. In view of the amendment(s) and remarks, the rejection of claims 1-9 under 35 U.S.C. 112, 1<sup>st</sup> paragraph has been withdrawn.
3. Applicant's arguments with respect to claims 1-6, 8 and 9 have been considered but are moot in view of the new ground(s) of rejection.
4. Claims 1-6, 8 and 9 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites, "(d') being obtained from a monomer mixture (d) containing..." and "(e') being obtained from a monomer mixture (e) containing...". It is not clear how the mixture of the monomers could be obtained if the amounts of the compounds (d-1) and (e-1) could be in the range from 10 to 100% by weight? Thus, if the amounts of (d-1) and (e-1) are equal accordingly to 100%, there are no the monomer mixtures because only one compound could be present as component (d") and (e') accordingly.

***Claim Rejections - 35 USC § 102***

6. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

***Claim Rejections - 35 USC § 103***

7. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

Claims 1-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Meyer et al. (U. S. Patent 5,854,346).

With regard to the limitations of claims 1-6, 8 and 9, Meyer discloses a toughened blend of an **aromatic polyester**, preferably an alkylene terephthalate, and most preferably poly(butylene terephthalate), with from **5 to 20 parts** (per 100 parts of polyester) of an **impact modifier**, which impact modifier is a blend of (a) 80 to 85 weight percent of a **core/shell impact modifier** having (1) from 70 to 90 parts of a **core** of a rubber which is a homopolymer of butadiene or a copolymer of butadiene with up to about 30% of at least one copolymerized vinyl monomer; (2) at least one **shell**, which shell is a homopolymer of methyl methacrylate or a copolymer which contains a majority of units derived from either methyl methacrylate or styrene; and b) 15 to 20 weight percent of a linear copolymer which contains from 50 to 85 parts of units derived from ethylene, from 5 to 40 parts of units derived from a C<sub>1</sub> –C<sub>8</sub> ester of (meth)acrylic acid, and from 2 to 10 parts of a copolymerizable monomer containing an **epoxy group** (col. 1, line 61 through col. 2, line 14).

With regard to the limitations of claim 1, Meyer does not disclose that the viscosity modifier (B) has a weight average molecular weight of 1,000 to 400,000.

However, in view of substantially identical composition between Meyer and instant claims, it is the examiner position that Meyer's impact modifier would appear to fall within this extremely broad MWT range. The burden is shifted to applicants' for evidence to the contrary. Since the USPTO does not have equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. In re Fitzgerald 619 F 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

Even assuming that the claims are not anticipated by the reference, it would have been obvious to one of ordinary skill in the art to make the polymer having the claimed property because it appears that the reference generically embrace the claimed subject matter and the person of ordinary skill in the art would have expected all embodiments of the reference to work. Applicants have not demonstrated that the differences, if any, between the claimed subject matter and the subject matter of the prior art examples give rise to unexpected products.

Furthermore, the rejection is made in the sense of In re Spada, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

Therefore, the property governing the claimed composition comprising a plurality of polymerizable components, such as weight average molecular weight, is inherently the same as or rendered obvious over Meyer, since Meyer's composition is essentially

the same as instantly claimed and comprises the identical chemical ingredients, as discussed above, and is used for the same purpose for providing a thermoplastic polyester resin composition comprising the viscosity modifier.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL M. BERNSHTEYN whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796

/Michael M. Bernshteyn/  
Examiner, Art Unit 1796

/M. M. B./  
Examiner, Art Unit 1796

